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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.    | CONFIRMATION NO. |
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| 09/820,598      | 03/29/2001  | Thomas M. Jessell    | 57477-A-PCT-US/JPW/MVM | 5690             |

7590 01/31/2005  
Cooper & Dunham LLP  
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EXAMINER

CARLSON, KAREN C

ART UNIT PAPER NUMBER

1653

DATE MAILED: 01/31/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Notice of Abandonment****Application No.**

09/820,598

**Applicant(s)**

JESSELL ET AL.

**Examiner**Karen Cochrane Carlson,  
Ph.D.**Art Unit**

1653

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--**

This application is abandoned in view of:

1. ☒ Applicant's failure to timely file a proper reply to the Office letter mailed on 14 July 2004.
  - (a) ☐ A reply was received on \_\_\_\_\_ (with a Certificate of Mailing or Transmission dated \_\_\_\_\_), which is after the expiration of the period for reply (including a total extension of time of \_\_\_\_\_ month(s)) which expired on \_\_\_\_\_.
  - (b) ☐ A proposed reply was received on \_\_\_\_\_, but it does not constitute a proper reply under 37 CFR 1.113 (a) to the final rejection.  
(A proper reply under 37 CFR 1.113 to a final rejection consists only of: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114).
  - (c) ☒ A reply was received on 18 August 2004 but it does not constitute a proper reply, or a bona fide attempt at a proper reply, to the non-final rejection. See 37 CFR 1.85(a) and 1.111. (See explanation in box 7 below).
  - (d) ☐ No reply has been received.
2. ☐ Applicant's failure to timely pay the required issue fee and publication fee, if applicable, within the statutory period of three months from the mailing date of the Notice of Allowance (PTOL-85).
  - (a) ☐ The issue fee and publication fee, if applicable, was received on \_\_\_\_\_ (with a Certificate of Mailing or Transmission dated \_\_\_\_\_), which is after the expiration of the statutory period for payment of the issue fee (and publication fee) set in the Notice of Allowance (PTOL-85).
  - (b) ☐ The submitted fee of \$\_\_\_\_\_ is insufficient. A balance of \$\_\_\_\_\_ is due.  
The issue fee required by 37 CFR 1.18 is \$\_\_\_\_\_. The publication fee, if required by 37 CFR 1.18(d), is \$\_\_\_\_\_.
  - (c) ☐ The issue fee and publication fee, if applicable, has not been received.
3. ☐ Applicant's failure to timely file corrected drawings as required by, and within the three-month period set in, the Notice of Allowability (PTO-37).
  - (a) ☐ Proposed corrected drawings were received on \_\_\_\_\_ (with a Certificate of Mailing or Transmission dated \_\_\_\_\_), which is after the expiration of the period for reply.
  - (b) ☐ No corrected drawings have been received.
4. ☐ The letter of express abandonment which is signed by the attorney or agent of record, the assignee of the entire interest, or all of the applicants.
5. ☐ The letter of express abandonment which is signed by an attorney or agent (acting in a representative capacity under 37 CFR 1.34(a)) upon the filing of a continuing application.
6. ☐ The decision by the Board of Patent Appeals and Interference rendered on \_\_\_\_\_ and because the period for seeking court review of the decision has expired and there are no allowed claims.
7. ☒ The reason(s) below:  
  
See Continuation Sheet

Petitions to revive under 37 CFR 1.137(a) or (b), or requests to withdraw the holding of abandonment under 37 CFR 1.181, should be promptly filed to minimize any negative effects on patent term.

Item 7 - Other reasons for holding abandonment: Applicants have filed a Miscellaneous Incoming Letter on Aug 19, 2004 setting forth an alleged discussion Applicants had with Mark Polutta of PTO's OPLA on August 13, 2004. Because the response was not a response to the Notice, this MIL did not come to the Examiner's attention until she was ready to abandon the case on Jan. 24, 2005. Mr. Polutta may advise Applicants on procedure, but he has no authority to remove an Office action with a shortened statutory period for response. Further the Examiner has discussed (in August, 2004 and again Jan. 24, 2005) the issue of unsigned documents with Mr. Polutta and we are in agreement that each piece of correspondence must be signed in accordance with Rule 1.4(d)(1): "Each piece of correspondence, except as provided in paragraphs (e) and (f) of this section, filed in an application, patent file, or other proceeding in the Office which requires a person's signature, must: (i) Be an original, that is, have an original signature personally signed in permanent ink by that person."

Applicants representative John P. White signed the transmittal authorizing fees filed May 13, 2004, signed the Information Disclosure Statement filed May 13, 2004, but did not sign the amendment filed May 13, 2004. Thus, it is not clear which if any of Applicants representatives made the amendments, or who takes responsibility for the amendments. Therefore, the Notice mailed July 14, 2004 stand

It is not understood why Applicants have allowed this application for patent go abandoned over an unexecuted amendment. The Examiner gave a courtesy call to John P. White on June 29, 2004 to provide a signed copy of the amendment. A woman named Maria Marucci returned the phone call and presented herself as an attorney having authority in the file. In fact, she is not recognized by the PTO as having authority to practice before the office. Ms. Marucci argued with me (the Examiner) that their office does this all of the time and that I was wrong to insist that the amendment be signed. I begged to differ, because the reason for the courtesy call was because omission of a signature on a document was unusual and had not been an issue that I have had with John P. White in the 13 yrs that I have been prosecuting applications with him. Ms. Marucci asked where I got the authority to insist that the amendment be signed. I told her that this was standard operating procedure and cited her Rule 1.4.

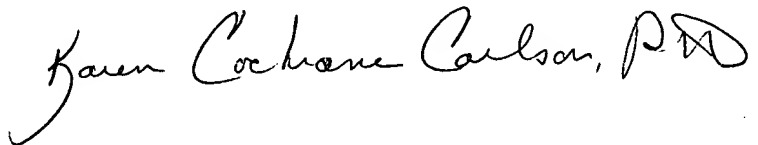
Ms. Marucci then called SPE Jon Weber regarding this situation. Dr. Weber also told Ms. Marucci that the amendment had to be signed and cited Rule 1.4. The Notice was sent to Applicants July 14, 2004.

On August 12, 2004, Mark Polutta from the PTO's OPLA provided a courtesy call to the Examiner regarding a conversation he had with Ms. Marucci. Ms. Marucci had telephoned him and argued with him that no signature is necessary on the amendment. Mr. Polutta informed me that I was correct to insist that the amendment had to be signed and that sending the Notice was appropriate.

On January 25, 2005, an e-mail exchange with Magdalene Greenleif, editor of the MPEP, confirmed that each piece of correspondence must be signed, in accordance to Rule 1.4.

No interview summaries of these conversations have been provided to make of record these conversations because Ms. Marucci is not authorized to practice before the PTO and because the merits of the case were not discussed. The conversation dates are derived from the Examiner's phone logs.

It is also noted that Applicants have missed the deadline for response for the Notice of Non-compliant Amendment mailed May 25, 2004.



KAREN COCHRANE CARLSON, PH.D.  
PRIMARY EXAMINER